

## **REMARKS**

In the Office Action, the Examiner objected to the drawing, objected to the disclosure, objected to claims 21 and 22, rejected claims 30, 31, 35 - 38 under the second paragraph of section 112, rejected claim 41 under section 101, rejected claims 20, 21, 25 - 27, 41 and 42 as anticipated by the Uematsu reference, rejected claims 29 - 40 as obvious over Uematsu in view of Heiney et al., rejected claims 22 - 24 as obvious over Uematsu in view of Goldsmith, rejected claims 28 as obvious over Uematsu in view of Porter, and made additional prior art of record.

### **Drawing Objection**

The specification has been amended to include the reference number 19 at the portion discussing the variable and merged data. The specification as been amended to add reference character 24 at the part discussing the optional indication for highlight color. The part number for the selection field 43 is added to the specification. The data stream 60 and printer 61 are also added to the specification. The drawing objections are thereby overcome. These elements are discussed in the specification and shown in the drawings. The amendments only add the missing numbers to the text of the specification, so no new matter is added.

Applicant notes that the missing part numbers are in a list of reference number submitted with the national stage papers at the end of the translated international application. For this reason as well, Applicant submits that no new matter is added by the specification amendments.

The drawings Figure 9 has been amended to change the reference character "56" to --49a--. A corresponding change in the specification has also been made. The objection is thereby overcome.

### **Disclosure Objection**

The specification changes suggested by the Examiner have been entered, so the objections are overcome.

### **Claims Objection**

The dependency of claim 21 has been changed to claim 20, so the objection is overcome. Claim 22 is cancelled without prejudice.

### **35 USC 112, 2nd ¶**

The dependence of the noted claims has been changed to correct the antecedent basis issue. Additional corrections are made as well. Applicants submit that the rejection is overcome.

### **35 USC 101**

The subject matter of claim 41 has been amended to claim a statutory invention.

### **35 USC 102(b)**

Uematsu discloses printing of peel and stick labels having constant data and variable data. A process is described wherein the constant and variable data is written to a buffer, the combined data is copied to another buffer, the variable data is erased from the second buffer and new variable data is written there to replace it. The erasing and writing of variable data continues as the labels are printed.

In the invention of this application, a master document has variable data and static data. The variable data is marked. The markings are used to remove the variable data from the static data. The static data is stored at the printer and only the variable data is sent to the printer in subsequent documents. The marking is provided by marking the variable data in a different color than the static data, preferably a color that the printer cannot print so that the markings do not appear in the printed output.

The cited reference does not show the claimed invention.

### **35 USC 103(a)**

The Uematsu reference is combined with Patent No. 5,649,024 to Goldsmith to reject the claims directed to marking of the variable data with color. Goldsmith discloses printing a document with highlight color by printing a document that has only black fonts on a color printer. The document has two different fonts and the printer is set to automatically convert one of the fonts from a black font to a color font prior to printing.

The present invention is not restricted to black and white printing only, but may be in particular realized when the marking is done in a color with lies outside a printable color

spectrum of said printer device. For example, if a printer is a highlight color printer which is capable to print two colors like black and blue, the marking may be done in red.

The claimed invention differs from the combination of Uematsu and Goldsmith because Goldsmith teaches away from the invention. Goldsmith calls for black fonts to be printed in color, whereas the claims calls for color markings to be provided in the document that are outside the printable spectrum of the printer so that the color markings do not appear. Goldsmith: no color markings; claims: color markings. Goldsmith: print in color; claims: print without color. Goldsmith: all data is variable; claims: color markings distinguishes static and variable data.

The combination with the other cited references also do not show the invention as claimed.

Thus, even the combined teachings of the art fail to suggest the claimed invention.


#### **Additional Art**

The additional art cited by the Examiner but not relied upon is noted by the Applicants.

#### **Conclusion**

Applicants respectfully request favorable reconsideration and allowance of the present application in view of the foregoing.

Respectfully submitted,



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## **IN THE DRAWINGS**

Amend Figure 9 as shown in the attached proposed amendment. In particular, a Replacement Sheet is enclosed with reference character 49a marked in place of reference character 56. An Annotated Sheet Showing Changes is also enclosed to show the proposed drawing change.

ANNOTATED  
SHEET TO SHOW CHANGES

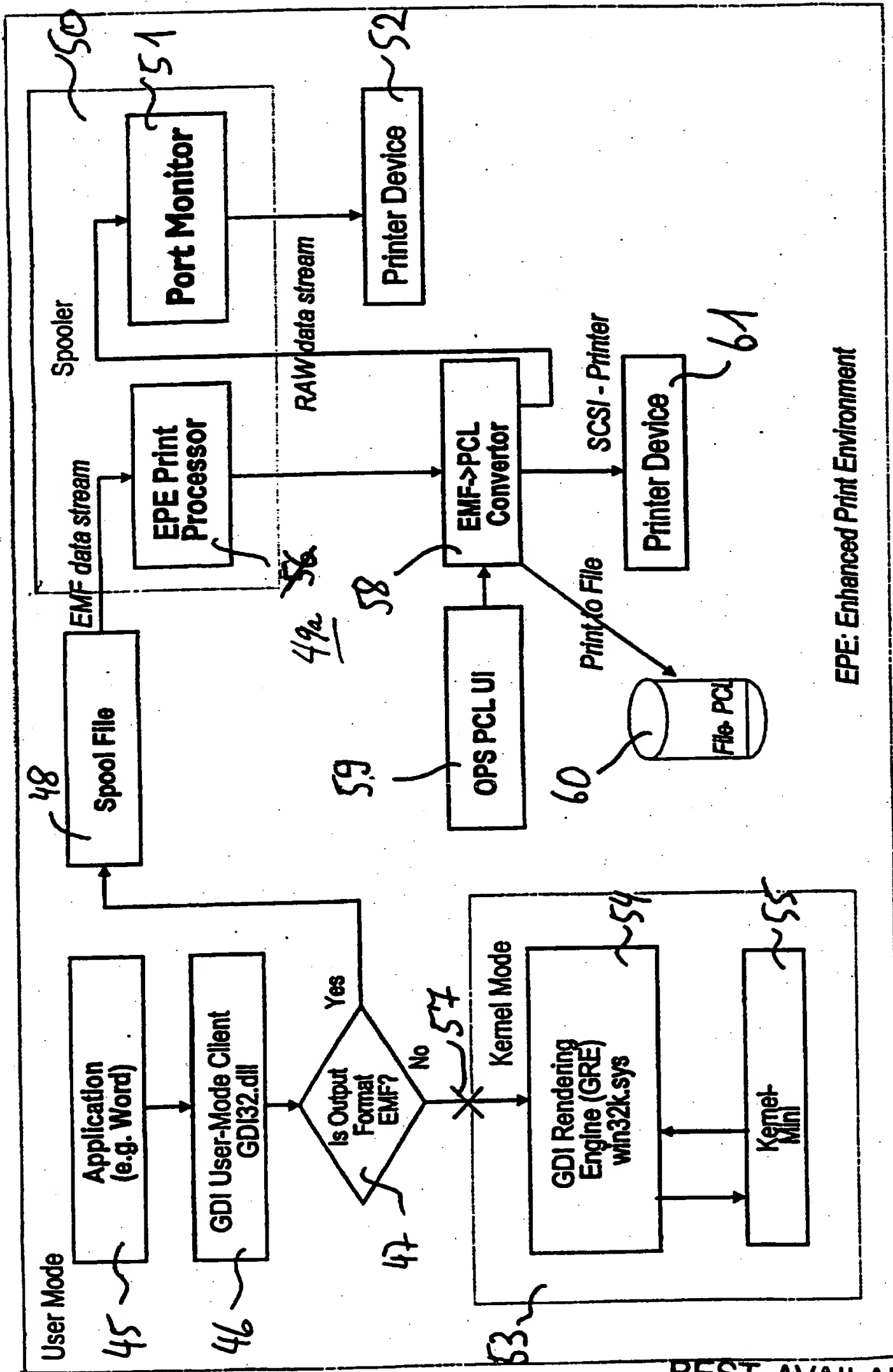


Fig. 9